

Remarks/Arguments:

I. Status

The Office Action dated December 13, 2005 (the "Office Action") has been carefully reviewed. Claims 1, 4, 11 and 12 have been amended to clarify the claimed invention. Accordingly, claims 1-22 are pending in this application. Reconsideration of this application is respectfully requested.

II. The Rejection of Claims 1-10 and 12-22 under 103(a) Should be Withdrawn.

In the Office Action, claims 1-10 and 12-22 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Pub. No. 2004/0008123 A1 to Carrender et al. (hereinafter "Carrender") in view of U.S. Patent No. 6,239,705 B1 to Glen (hereinafter "Glen"). The Applicants respectfully traverse.

Discussion Regarding Patentability of Claim 1

1. Claim 1

Claim 1, as amended, recites:

An orthopaedic component for engagement to the human body, comprising:
a component body; and
a radio frequency identification (RFID) tag configured for storing information related to the orthopaedic component, said RFID tag associated with said component body so that the stored information can be accessed by an independent reader.

Claim 1 thus recites a radio frequency identification (RFID) tag associated with a component used to replace a portion of the skeletal system.

2. Glen Has Been Mischaracterized

Claim 1 has been rejected based primarily upon Carrender. The Examiner has acknowledged, however, that Carrender fails to disclose an orthopaedic component. (Office Action at page 2). The Examiner alleges that “Glen teaches the use of a medical implant component being an orthopedic component.” (Office Action at page 2). Respectfully, Glen has been mischaracterized.

Specifically, the Examiner has cited to figures 3-5 of Glen for disclosing an orthopaedic component. (Office Action at page 2). Figures 3-5 of Glen, however, show the use of a tracking device that is housed within prosthetic teeth. (Glen at column 5, lines 1-3). As set forth at page 878 of *Gray's Anatomy*, 15th Ed., Crown Publisher's Inc. (1977), “teeth are an evolution from the dermoid system, and not of the bony skeleton.” (A copy is provided herewith as Exhibit I). Consequently, a prosthetic tooth is not an orthopaedic component.

Accordingly, Glen does not disclose a device associated with an orthopaedic component as recited in claim 1. Therefore, even if Carrender is modified as proposed in the Office Action, such modification does not arrive at the invention of claim 1. Thus, a *prima facie* case of obviousness has not been presented and the rejection of claim under 35 U.S.C. 103(a) should be withdrawn.

3. There is No Motivation for the Proposed Modification

Moreover, there is no motivation for the proposed combination. Specifically, the Examiner has stated the motivation is found in “the purpose of effectively monitoring the orthopedic component.” (Office Action at page 2). As noted above, Glen does not

disclose an orthopaedic component. Thus, the Examiner has failed to identify any teaching in the prior art of a desire to track an orthopaedic component.

The Federal Circuit has stated that “[the] factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002)(internal citations omitted). Neither Carrender nor Glen disclose the use of a device with an orthopaedic component as disclosed in the Applicants’ specification. Thus, the only source for the motivation identified by the Examiner is the Applicants’ teaching.

Therefore, the Examiner has not set forth a sufficient basis or identified a proper source for the proposed motivation to combine the teachings of Carrender with the teachings of Glen. Therefore, under MPEP § 2143.01, the Examiner has failed to present a *prima facie* case of obviousness and the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn.

4. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 1 as being obvious over Carrender in view of Glen 35 U.S.C. § 103 should be withdrawn.

Discussion Regarding Patentability of Claim 2-10 and 12-16

The Examiner has rejected claims 2-10 and 12-16 based upon the same combination of Carrender and Glen discussed above with respect to claim 1. Claims 2-10 and 12-16 depend from claim 1 and include all of the limitations of claim 1 as well as additional limitations. Therefore, for at least the same reasons set forth above with respect to claim 1, claims 2-10 and 12-16 are allowable over the prior art.

Discussion Regarding Patentability of Claim 17-22

The Examiner has rejected claims 17-22 based upon the same combination of Carrender and Glen discussed above with respect to claim 1. Claim 17 is an independent claim which recites “engaging the information storage device to the orthopaedic component.” Claim 17 thus requires a device to be attached to a component used to replace a portion of the skeletal system. For purposes of the present rejection, this element is the same as the element discussed above with respect to claim 1. Therefore, for at least the same reasons set forth above with respect to claim 1, claim 17 is allowable over the prior art.

Claims 18-22 depend from claim 17 and include all of the limitations of claim 17 as well as additional limitations. Therefore, for at least the same reasons set forth above with respect to claim 17, claims 18-22 are allowable over the prior art.

III. The Rejection of Claim 11 under 103(a) Should be Withdrawn.

In the Office Action, claim 11 was rejected under 35 U.S.C. 103(a) as being obvious over Carrender Glen in further in view of U.S. Patent No. 6,400,272 B1 to Holtzman et al. (hereinafter "Holtzman"). The Applicants respectfully traverse.

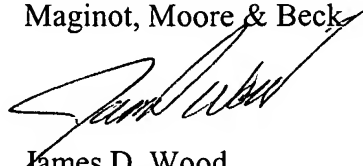
Discussion Regarding Patentability of Claim 11

Claim 11 depends from claim 1 by way of claims 8 and 10 and includes all of the limitations of claim 1. The Examiner has rejected claim 11 based primarily upon Carrender and Glen with reliance on Holtzman for teaching the use of an EEPROM. (Office Action at page 5). Accordingly, Holtzman fails to correct the deficiencies discussed above with the combination of Carrender and Glen regarding the elements of claim 1. Therefore, a *prima facie* case of obviousness has not been presented with respect to claim 11 and the Examiner is respectfully requested to withdraw the rejection of claim 11.

IV. Conclusion

A prompt and favorable action on the merits is requested.

Respectfully Submitted,
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